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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/293,509 | 04/15/1999 | AKIRA OSAWA | RM.HPN | 4957 |

7590

06/17/2003

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EXAMINER

WHITE, CARMEN D

ART UNIT

PAPER NUMBER

3714

DATE MAILED: 06/17/2003

26

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/293,509

Applicant(s)

OSAWA, AKIRA

Examiner

Carmen D. White

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2 and 5-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 5-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 31, 2003 has been entered.

Double Patenting

The Double Patenting Rejection of instant claims 1-2, and 5-14 over the claims of copending application 09/268,960 set forth in the previous office action (Paper #21) is hereby repeated and incorporated by reference. The claims as amended in the instant application and as amended in copending application 09/268,960 are still not patentably distinct. As previously noted, this rejection can be overcome by a timely filed terminal disclaimer. Until that terminal disclaimer is actually filed, the rejection still stands.

The examiner appreciates Applicant's notification to file a terminal disclaimer at such time as allowable subject matter is indicated.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2 , 4-12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Marnell II* or *Farrell*.

Regarding the instant claims, Marnell or Farrell teaches a gaming machine for use by a player, the gaming machine comprising a variable display (Marnell- Fig. 2, #22a; Farrell (Fig. 1, #2) for displaying graphical information corresponding to at least one of a plurality of graphical elements necessary for a principal game, the principal game having associated therewith a plurality of predetermined display states; a controller coupled to the variable display for causing the variable display to display the graphical information; and a secondary display (Marnell Fig. 2, #23a) having a plurality of display areas for displaying a number of symbol images of a single kind corresponding to one of the plurality of predetermined display states displayed as a result of the principal game, the number of the symbol images of a single kind displayed in each of the display areas being increased each time that the principal game results in the one of the predetermined display states, thereby advancing a secondary game.

Marnell or Farrell is silent on the explicit disclosure of displaying *only* a single kind of display images, which is the feature that applicant argues for patentability. Applicant indicates Fig. 3, display areas #6a1 and #6a3, of the instant disclosure, for teaching this feature. However, the examiner does not understand, by looking at this figure and reading the claim language, how the instant claimed invention is patentably distinct from the primary and secondary displays of Marnell or Farrell. Marnell, in Fig. 2, shows a plurality of display areas in which a number of symbol images of a single kind (see four images in display areas of #23a that show the symbol "**BAR**"). While Fig. 2

shows other images as well it still shows a number of symbol images of a single kind ("**BAR**"). Similarly, Farrell shows in Figure 1, #6, a number of symbol images of a single kind "**O**".

Applicant argues the feature as though only a single kind of image is shown in the secondary display. However, this is not what Fig. 3 of the instant disclosure shows. As the examiner stated in the previous office actions, the gaming machine of Marnell or Farrell are functionally capable of displaying a single kind of image. This is merely a matter of modifying the symbol image software. Further, the examiner asserts that it would have been obvious to a person of ordinary skill in the art at the time of the invention to include the display of **only** a single kind of image in the secondary display of the gaming machine of Marnell or Farrell in order to simplify the game and make it easier for beginning players.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Marnell** II (5,393,057) or **Farrell** (GB 2242300A) in view of **Wilson**, Jr. et al (6,004,207) or **Adams** (5,848,932).

Regarding claim 13, Marnell or Farrell discloses all the limitations of the claim as discussed above. Marnell or Farrell lacks disclosing a multiplied payout. In an analogous gaming machine, Wilson or Adams discloses the multiplication of a payout value (Wilson- abstract; Adams- abstract). It would have been obvious to a person of ordinary skill in the art at the time of the invention to include this feature in Marnell or Farrell in order to provide multiplied payouts in slot machines to increase players' interests and financial reward in the game.

Examiner's Response to Applicant's Remarks

Applicant argues that Marnell II or Farrell does not teach the feature of a plurality of secondary display areas for displaying a number of a single kind of symbol images. Applicant seems to be describing this feature in the arguments as the display of only a single kind of symbol images. However, this is not what is claimed and this is not what is illustrated in Fig. 3, which Applicant asserts teaches this feature. The examiner can see no patentable distinction between the cited prior art of Marnell or Farrell and the instant claims and Figure 3 regarding the feature of the display of a single kind of image (please see the above claim rejections). Therefore, the claim rejections over the cited prior art remain.


USPTO Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carmen D. White whose telephone number is 703-308-5275. The examiner can normally be reached on Monday through Friday, 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7768 for Non-official communications and 703-305-3579 for Official communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1078.


cdw


S. THOMAS HUGHES
SUPERVISORY PATENT EXAMINER
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